

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 and 20 have been amended. No new matter has been added.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-20 are now pending in this application.

Information Disclosure Statement

Applicant requests that the Examiner consider the references cited in the Information Disclosure Statement filed on February 16, 2006, make those references of record in the application, and return an initialed copy of the Form PTO/SB/08 submitted with the Information Disclosure Statement.

Allowable subject matter

Applicant appreciates the indication that claims 8-19 are allowed.

Rejections under 35 U.S.C. § 103

Claims 1-4 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,698,098 to Ernst et al. ("Ernst") in view of U.S. Patent No. 5,902,479 to Fukumori et al. ("Fukumori"). Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ernst in view of Fukumori, and further in view of U.S. Patent No. 5,066,391 to Faria et al. ("Faria"). Applicant respectfully traverses these rejections for at least the following reasons.

Independent claim 1, as amended, recites "wherein when the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit so that upon removal of the cover, the inner tubular member protrudes from the recessed portion of the cover to increase

the total volume of the inner tubular member and the cover.” Neither Ernst, nor the remaining references applied in the rejection, suggest at least this feature in the context of claim 1, nor the advantages attendant thereto.

The Office Action equates the cover 12, sliding valve 15, and compression spring 18 of Ernst with the cover, inner tubular member, and biasing unit as recited in claim 1. In contrast to claim 1, however, the sliding valve 15 is not pushed down into any recessed portion of the cover 12 against a bias of the compression spring 18 so that upon removal of the cover 12 the sliding valve 15 protrudes from the recessed portion of the cover 12 to increase the total volume of the sliding valve 15 and the cover 12. Rather, Ernst merely discloses that as soon as the cover 12 is unscrewed from the filter housing 10 the sliding valve 15 is shifted upward by the force of the compression spring 18 and thus opens the oil drain opening 17 so that the oil in the filter housing can drain out. The compression spring 18 of Ernst, however, does not bias the sliding valve 15 to increase the total volume of the sliding valve 15 and the cover 12. Because the compression spring 18 biases the valve 15 into the cover, the total volume is not increased.

Fukumori was cited for disclosing an inlet and outlet or a seal member, and as such does not cure the deficiencies of Ernst. Faria was cited for disclosing other features of the claims and also fails to cure the deficiencies of Ernst.

Moreover, Ernst fails to suggest the advantages of the structure of the oil filter of claim 1. In claim 1, because upon removal of the cover from the housing main body, the inner tubular member is moved relative to the cover under the bias of the biasing unit so that the total volume of the inner tubular member and the cover is increased, the amount of oil that can be held in the inner tubular member and the cover is increased. This enables the filter to be readily replaced without causing oil remaining within the housing main body to be splashed or scattered to the outside at the time of replacement of the filter. By contrast, the filter of Ernst is not constructed so as to hold, upon removal of the cover 12, the remaining oil within the cover 12 or the housing 10 for preventing the oil from being splashed or scattered to the outside. Instead, it appears that in the Ernst filter, the oil drained out will be splashed

or scattered upon removal of the cover 12, unless there is provided some means for holding the oil there within.

Independent claim 20 recites “wherein when the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit so that upon removal of the cover, the inner tubular member protrudes from the recessed portion of the cover to increase the total volume of the inner tubular member and the cover”, and is thus patentable for reasons analogous to claim 1.

Dependent claims 2-7 ultimately depend from claim 1 and are patentable for at least the same reasons.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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